

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-46 are pending in the application, with claims 1, 9, 17, 23, 31, 35, and 38 being the independent claims. Claims 1, 9, 17, 23, 35, and 38 are sought to be amended. These amendments are believed to introduce no new matter, and their entry is respectfully requested.

Based on the foregoing amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Objection to the Claims

Paragraph 1 of the Claim Objections section of the Office Action objects to claims 23-30 and 45-46 as allegedly having no support in the specification. Applicants respectfully traverse the objection.

The language of claims 23-30 and 45-46 apparently at issue is "tangible computer readable storage medium." Applicants respectfully submit that the specification supports this recitation without change. For example, paragraph [0068] of the present specification recites, in part, "[s]uch software can be disposed in any known computer usable medium including semiconductor, magnetic disk, optical disk (e.g. CD-ROM, DVD-ROM, etc.).]" It is indisputable that those having skill in the relevant art would recognize "semiconductor, magnetic disk, optical disk (e.g. CD-ROM, DVD-ROM, etc.)" as examples of a "tangible computer readable storage medium." Applicants respectfully submit any contrary assertion lacks any serious foundation. Indeed, the recommendation in the Office Action to amend

the specification to read "[s]uch software can be disposed in any known computer usable medium including computer readable storage medium such as semiconductor, magnetic disk, optical disk (e.g. CD-ROM, DVD-ROM, etc.)...." mandates this very conclusion. That is, to make the recommendation, the Examiner must have clearly understood that "semiconductor, magnetic disk, optical disk (e.g. CD-ROM, DVD-ROM, etc.)" are examples of "computer readable storage medium."

In essence, the objection amounts to nothing more than requiring Applicants to use the exact words from the specification in the claims. This requirement is contrary to well-established law. Simply stated, there is no requirement that the language of the claims appear *ipsis verbis* in the specification. *Ex Parte Holt*, 19 U.S.P.Q. 2d 1211 (1991) (restating that "it is well established that the invention claimed need not be described *ipsis verbis* in order to satisfy the disclosure requirement of § 112"); MPEP § 2163(II)(A)(3)(a) (If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 U.S.P.Q. 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient") (Emphasis added).

In response to the allegation in the office action that "it isn't clear whether paragraph [0068] refers to the 'computer readable storage medium' found in the claims," Applicants respectfully submit this is clear from the specification. However, in an effort to expedite prosecution with respect to this issue, Applicants state the term "computer readable storage medium" found in the claims of the present application means "any known computer

readable storage medium including “semiconductor, magnetic disk, optical disk (e.g. CD-ROM, DVD-ROM, etc.)” as provided in paragraph [0068]. Further, Applicants state the term “computer readable storage medium” used in the claims of the present application does not include computer useable transmission medium such as carrier waves.

In view of the foregoing, Applicants submit that is unnecessary to amend the specification as suggested by the Examiner and maintain that the present specification sufficiently supports the language of claims 23-30 and 45-46. Applicants respectfully request that the Examiner reconsider and withdraw the present objection to the claims.

Rejections under 35 U.S.C. § 102

On page 2 of the Office Action, claims 1-4, 7-12, 15-20, 23-26, 29-41, 43, and 44-46 under 35 U.S.C. § 102(b) were rejected as being anticipated by U.S. Patent No. 6,430,674 to Trivedi *et al.* (hereinafter Trivedi). For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection.

Claim 1 recites, in part, "a first recoder to map an instruction from one encoded state to another encoded state" and a second recoder to map an instruction from one encoded state to another encoded state, the second recoder coupled to the first recoder." (Emphasis added). Thus, claim 1 requires at least two recoders, each of which maps an instruction from one encoded state to another encoded state. Applicants respectfully submit that Trivedi does not disclose two recoders.

The Office Action contends that item 306 of Figure 3, labeled “Detector” or the "circuitry" discussed at col. 4 lines 17-33 of Trivedi discloses one of a first or second recoder. Applicants respectfully submit this is not the case.

As explained in the present application, a recoder, “maps instructions from one encoded state (*e.g.*, a 16-bit instruction) to another encoded state (*e.g.*, a 32-bit instruction).” Consistent with this definition of the term “recoder,” the “first recoder” recited in claim 1 is “to map an instruction from one encoded state to another encoded state.” Likewise, the “second recoder” recited in claim 1 is “to map an instruction from one encoded state to another encoded state.” Trivedi’s reference 306, labeled “Detector,” does no such mapping. Rather, Trivedi’s detector 306 detects the presence of a mode switch instruction and generates a speculative wake up. (*See* Fig. 3 reference 306, col. 4 lines 24-33, and col. 6 lines 29-55). Thus, Trivedi’s detector 306 is not a recoder as suggested in the Office Action. Assuming Trivedi’s translator 302c were the “first recoder” recited in claim 1, Applicants respectfully submit no circuitry discussed in Trivedi is analogous to the “second recoder” recited in claim 1.

Therefore, even if the Applicants were to concede, which they do not, that reference 302c of Figure 3 of Trivedi, labeled “Translator,” is a recoder, there would still be only one recoder disclosed in Trivedi. Because there would be only one disclosed recoder, Trivedi does not disclose both a “first recoder” and a “second recoder” as recited in claim 1. Because Trivedi’s at most discloses only a single recoder, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 1 set forth in paragraph 2 of the Office Action.

Each of claims 9, 17, and 23 recite “a first recoder to map an instruction from one encoded state to another encoded state” and claims 9 and 23 recite “a second recoder to map an instruction from one encoded state to another encoded state, the second recoder coupled to the first recoder.” Claim 17 recites, “a second recoder that recodes.” As explained above

with respect to claim 1, Applicants respectfully submit Trivedi does not disclose both “a first recoder” and “a second recoder” as recited in claims 9, 17, and 23. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 9, 17, and 23 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Claim 31 recites an “expand instruction” and an “expandable instruction.” Page 7 of the Office Action equates the recited “expand instruction” and “expandable instruction” to a prefix instruction and a target instruction respectively. First, Applicants found no mention of a “prefix instruction” and a “target instruction” in Trivedi. For that reason alone, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 31 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Moreover, Applicants respectfully submit Trivedi discloses nothing remotely similar to the concept of the “expand instruction” and “expandable instruction” recited in claim 31. Paragraph [0043] of the present specification defines an “expand instruction” as “an instruction having data bits that are added or concatenated to bits of a second expandable instruction, thereby expanding an immediate value held in an immediate field of the expandable instruction.” Applicants respectfully submit Trivedi discloses no such expand instruction. For at least the foregoing reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 31 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Claim 35 recites “dispatching the first instruction to a first recoder that maps an instruction from one encoded state to another encoded state and the second instruction to a second recoder that maps an instruction from one encoded state to another encoded state.” As explained above, Applicants respectfully assert that Trivedi does not disclose both a “first

recoder" and a "second recoder" as recited in claim 35. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 35 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Claim 38 recites "a plurality of recoders that operate in parallel, each recoder mapping an instruction from one encoding state to another encoding state." (Emphasis added.) As explained above, Applicants respectfully assert that Trivedi does not disclose a plurality of recoders as recited in claim 38. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 38 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Claims 2-4 and 7-8 are dependent on independent claim 1. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 2-4 and 7-8 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Claims 10-12 and 15-16 are dependent on independent claim 9. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 10-12 and 15-16 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Claims 18-20 are dependent on independent claim 17. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 18-20 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Claims 24-26 and 29-30 are dependent on independent claim 23. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 24-26 and 29-30 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Claims 32-34 are dependent on independent claim 31. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 32-34 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Claims 36-37 are dependent on independent claim 35. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 36-37 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Claims 39-41, 43, and 44-46 are dependent on independent claim 38. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claims 39-41, 43, and 44-46 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

For at least the foregoing reasons, Applicants respectfully request Examiner reconsider and withdraw the rejections of claims 1-4, 7-12, 15-20, 23-26, 29-41, 43, and 44-46 under 35 U.S.C. § 102(b) set forth on page 2 of the Office Action.

Rejections under 35 U.S.C. § 103

On page 11 of the Office Action, claims 5, 6, 13, 14, 21, 22, 27, 28, 42, and 44 under 35 U.S.C. § 103(a) were rejected as allegedly being unpatentable over Trivedi in view of Common Art. For at least the following reasons, Applicants respectfully request the Examiner reconsider and withdraw the rejection.

Claims 5, 6, 13, 14, 21, 22, 27, 28, 42, and 44 are dependent on independent claims 1, 9, 17, 23, 31, 35, and 38 respectively and since Trivedi does not teach or suggest all of the elements of the independent claims 1, 9, 17, 23, 31, 35, and 38, it also does not teach or suggest all of the elements of dependent claims 5, 6, 13, 14, 21, 22, 27, 28, 42, and 44.

Applicants respectfully submit the Common Art does not overcome the deficiencies of Trivedi.

For at least these reasons, Applicants respectfully request that the 35 U.S.C. § 103(a) rejections be removed from claims 5, 6, 13, 14, 21, 22, 27, 28, 42, and 44 and that these claims be allowed.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



David C. Isaacson
Attorney for Applicants
Registration No. 38,500

Date: October 17, 2008

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

885433_2.DOC